



UNITED STATES PATENT AND TRADEMARK OFFICE

cll

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,978	02/06/2002	Eric E. Swayze	IBIS-0403	1815
34138	7590	03/31/2006		
COZEN O'CONNOR, P.C. 1900 MARKET STREET PHILADELPHIA, PA 19103-3508			EXAMINER HABTE, KAHSA Y	
			ART UNIT 1624	PAPER NUMBER

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,978

Applicant(s)

SWAYZE ET AL.

Examiner

Kahsay Habte

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-21,63 and 65-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 63 and 65-72 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1 and 3-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. Claims 1, 3-21, 63 and 65-72 are pending in this application.

Response to Amendment

2. Applicant's amendment filed 03/21/2006 in response to the previous Office Action (1/26/2006) is acknowledged. Rejection of claims 63 and 65-72 under 35 U.S.C. § 112, second paragraph (item 6) has been obviated. Even though applicant's amendment overcame the second paragraph rejection and objections raised in previous Office Action, the amendment raise minor issues. Also upon review of claim 1, it is deemed necessary to raise minor issues for informalities.

Claim Objections

3. Claim 1 is objected to because of the following informalities: In claim 1, the phrase "R₁ is alkyl, aryl.....heteroaryl; heteroarylalkyl, heterocycloalkyl" is objected to because of the recitation of the term "heteroaryl" with semicolon. Note that the recitation of "heteroaryl;" implies that heteroaryl is the last choice for variable R₁. Since this is not the case, it is recommended that applicants change the semicolon to comma to overcome this objection. Claim 1 should read as "R₁ is alkyl, aryl.....heteroaryl, heteroarylalkyl, heterocycloalkyl".
4. Claim 18 is objected because there is no period at the end of the claim (i.e. after the last chemical structure).

Art Unit: 1624

Claims 3-17 and 19-21 are also objected to of being dependent upon objected claim 1.

Response to arguments

Applicant's argument filed 03/21/2006 has been fully considered but it is not persuasive.

In previous claim set (12/19/2005), there were two periods at the end of the last chemical structures on pages 8 and 9. The first period was after the deleted chemical structures on page 8 (the period was not underlined to indicate deletion). The second period was after the last chemical structure at page 9. Currently the clean claim set does not have a period at the end of the claim. It appears that applicants forgot to insert a period after taking the deleted chemical structures and the lines from the replaced chemical structures. It is recommended that applicants insert a period after the chemical structure as it was done in claims 11 and 19.

The examiner recommends that applicants send a clean set of claims, since the previous claim sets appear to have a vertical line in the pages (e.g. see pages 8-10 of the current claim set).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1624

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

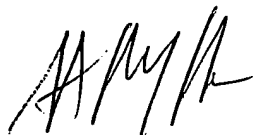
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 1624

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Kahsay Habte', is positioned above the printed name.

Kahsay Habte
Primary Examiner
Art Unit 1624

March 29, 2006